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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/541,795	03/31/2000	James Link	6446.US.P2	3564

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WASHINGTON, DC 20005

EXAMINER

PATEL, SUDHAKER B

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 03/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/541,795

Applicant(s)

LINK ET AL.

Examiner

Sudhaker B. Patel, D.Sc.Tech.

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 03 February 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 25 February 2004. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☒ Newly proposed or amended claim(s) 1-7,9,10,12-14,16-19 and 26-37 would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See attached note.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 8,11 and 15.Claim(s) objected to: 38-43.Claim(s) rejected: 1-7,9,10,12-14,16-19 and 26-37.Claim(s) withdrawn from consideration: 20-25 and 44-60.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☒ Other: See attached interview summary and note.

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### DETAILED ACTION

Applicants communication paper dated 2/24/2004 is acknowledged. There is no cancellation or amendment(s) to claims. Upon further review and reconsideration this application is found not ready for the allowance at this stage for the reasons stated below. See interview summary dated 3/8/04.

### *Election/Restrictions*

Applicants have elected without traverse invention of Group I and species of Example 399(see specification page 349) as per their paper dated 3/21/03. The **restriction /election has been made FINAL** in earlier Office Action paper dated 8/26/03. Claims 20-25,44-60 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a non-elected subject matter, there being no allowable generic or linking claim.

### *Claim Rejections - 35 USC § 112*

1. Claims 1-7,9,10,12-14,16-19,26-37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention for the already stated in earlier Office communication paper dated 8/26/03. Applicants have not amended the claims to exclude the other meanings of the terms then for the allowable subject matter. See interview summary dated 3/8/04 attached with this communication. Following additional reasons also apply.

2. Claim 1 as presented can not accommodate the species of Example 399, because the definition of Ar as substituted aryl wherein the substituent is either unsubstituted heterocyclyl or unsubstituted heterocyclylalkyl does not exactly and definitely describe the nature of the ring, exact number and nature of arrangement of heteroatoms, and the exact point of connection with the carbon atom of the phenyl ring. i.e. unsubstituted N-unsubstitutedphenyl- piperidine (which is fully saturated heterocycle with 1 N atom. Accordingly, correction is required.

3. Independent Claim 37 describes the compound which is a diaryl sulfide cinnamide "comprising" of..... This is not the exact description of a compound with a ring because when the aryl or heteroaryl is substituted, the claim does not exactly and specifically describe the position(s) & number of other substituents, nature, number,

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arrangement of the heteroatoms (where applicable), and the exact point of attachment of the cinnamide bridge in the heteroaryl ring, although the claim describes the position of the this bridge in the phenyl ring. Is cinnamide bridge in the heteroaryl portion absent? Correction is required.

### ***Claim Objections***

4. Claims 38-43 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. These claims present the invention of Formula III without any provisos and are broader inscope than the main claim 1. There is duplication of the subject matter as well.

5. Claims 12, 13 are objected under 37 CFR 1.141(a) because in addition to the elected species of Example 399, they include more than 450 separate compounds and are in no way constitute a reasonable number of species for the examination purpose for limited time available for a through search/examination of an application to the examiner.

### ***Conclusion***

#### **Examiner's Position:**

6. The declaration filed on 2/24/04 under 37 CFR 1.131 is sufficient to overcome the 102(e) ref. U.S.P. 6110922 reference.

7. Applicants' arguments and remarks for the Provisional Double Patenting rejection against the co-pending U. S. Patent Application Sr. No. 09695040 filed 10/24/2000, and U.S. Application Sr. NO. 10356794 filed 8/29/2002 have been considered, but not found persuasive because applicants have not agreed to provide necessary terminal declaration(s) to comply with 37 CFR 3.73(b). Instant claims 1-10, 12-14, 16-19, 26-43 overlap with the said co-pending applications' compounds of Formula I of ref. '794 man claim 1 (see page 2 of amendment dated 12/12/2003, claim 32 on page 39, composition claim 15, and method of use claims 16-19 overlap with the instant claims. As stated in the earlier Office communication paper dated 8/26/03 the claims 1-19, 26-31, 34-45, 47-57 of the co-pending application ref. '040 overlap with the instant claims. 37 CFR 1.130(b).

8. Instant claims differ from the above stated claims of the co-pending U.S. Applications ref. '794 & '040 by reciting a broader genus but they also read onto the ref. claims, which would extend, the monopoly of the U.S.P. 6110922.

9. Note the instant application and co-pending applications are not arising out of restriction/election process for U.S. Application Sr. NO. 09222491 filed 12/29/1998.

10. It is also noted that applicants **have not surrendered the U.S.P. 6110922** so far.

11. Under the above stated situation, examiner has searched the subject matter related to species of Example 399, and claims 8, 11, 15 only. i.e. Subject matter of invention of Group I wherein the generic core (= AR-S- Phenyl-CH=CH-CONR10R11)

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has following meaning only: AR = substituted phenyl or substituted heterocycle (= pyridine, 1,3-benzimidazole, -2-one, 1,4-benzodioxane, 1,3-benzodioxole, indole, isatin, quinoline, quinazolin-4-one. See following various references, which are not properly excluded in the claims and provisos of the instant application.

12. DE 4030041 dated 3/1991 also cited as Chemical Abstract DN 117:111634. The ref. '041 teaches compounds of Formula I with a core: "Heterocycle-S- substituted Phenyl-S-heterocycle". This core and compounds overlap with the instant claim(s), namely claims 1,37,47,52 **wherein no cinnamide bridge is present.**

13. WO 9822423 dated 5/1998, also cited as Chemical Abstract DN 129:40990. The ref. '423 teaches compounds of Formula I with a core: " (Un) substituted phenyl-S- (un) substituted divalent benzene, furan, thiophene, pyridine-CH==CH-R1 wherein R1 is Me, CH2OR5, OR5, COR6 (R5 = H, alkyl, acyl; R6 = H, alkyl, (un) substituted NH2 or OH). This core and compounds overlap with the instant claim(s), namely, claims 1,37,47,52 wherein Cinnamid bridge is present.

14. EP 722928 dated 7/1996, also cited as Chemical Abstract DN 125:167598. The ref. '928 teaches compounds of Formula I with a core: " substituted phenyl-S- substituted Phenyl. See compounds XXIII; XVII; VIIIa; VIIIb in page 23 and definition of R4 on page 11 lines 15-17". This core and compounds overlap with the instant claim(s), namely claims 1,37,47,52 wherein no cinnamide bridge is present.

15. WO 9813347 dated 4/1998. The ref. '347 teaches compounds of Formula I (see claim 1 in page 43) COOH/CH2OH (or Tetrazole/heterocycle-S) -Phenyl or pyridine (-CR1=CH-CONR3R2) -S- (un) substituted Aryl or heterocycle: " This core and compounds overlap with the instant claim(s), namely, claims 1,37,47,52 wherein cinnamide bridge is present.

#### ***Allowable Subject Matter***

16. Claims 8,11,15 are allowed. Claims 1-7,9,10,19 which will consist of subject matter searched and elected for the invention of Group I only, would also be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph and other rejections/objections/requirements, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sudhaker B. Patel, D.Sc.Tech. whose telephone number is (571) 272-0671.

The examiner can normally be reached on 6:30 to 5:00 pm (Monday-Thursday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Mukund J. Shah can be reached on (571) 272 0674 or Sr. Examiner Mr. Richard Raymond at (571) 272 0673 or Mr. James O. Wilson at (571) 272-0661.

The assigned centralized fax number for the organization/USPTO for processing of this application or its proceedings is (703)-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 1235.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

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published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Sudhaker B. Patel, D.Sc. Tech.  
March 9, 2004.



MUKUND SHAH  
SUPERVISORY PATENT  
EXAMINER  
ART UNIT 1624

2/12/04